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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/846,632	05/01/2001	Andrew D. Dubner	56650US002	4391

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EXAMINER

FRIDIE JR, WILLMON

ART UNIT PAPER NUMBER

3722

DATE MAILED: 02/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/846,632

Applicant(s)  
Dubner et al.

Examiner  
Willmon Fridie

Art Unit  
3722



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Nov 18, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4,6,8 6) ☐ Other:

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## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,2,14,23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by

Wang.

Wang discloses all of the subject matter as set forth in the claims and is identical to the invention as broadly recited. Some of the claimed elements clearly disclosed by the reference are: a transparent fragile layer(11) and a transparent durable layer (12). Further Wang inherently teaches the method in claims 23 and 24.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang.

Wang discloses the claimed invention except for claimed layer materials. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use any suitable material, since it has been held to be within the general skill level of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

6. Claims 3,5,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view of Killey.

Wang discloses the claimed invention except for a holographic foil layer. Killey teaches that it is well known in the art to use a holographic foil layer in its assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide

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Wang with a holographic foil layer in the manner as taught by Killey in order to enhance the security feature.

7. Claims 4,6,7,13,15,16,19,20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang in view McConville et al..

Wang discloses the claimed invention except for a retroreflective layer of glass beads. McConville et al teaches that it is well known in the art to use a a retroreflective layer of glass beads in its assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Wang with a retroreflective layer of glass beads in the manner as taught by McConville et al in order to enhance the security feature.

McConville et al further teaches that it is well known to use a composite assembly of the claimed elements in a document of value.

### ***Response to Arguments***

8. Applicant's arguments filed 11/18/02 have been fully considered but they are not persuasive.

In response to applicants argument that Wang does not disclose a transparent layer that is fragile, the examiner submits that Wang discloses that the transparent layers are made of “transparent thin film materials” at column2, line 32, hence the layers are deemed to inherently fragile due to their reduced thickness and Wang anticipates the claimed subject matter as broadly presented.

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In response to applicants argument that Wang does not disclose printed identification or verification information (security element). The examiner submits that Wang clearly discloses a laminated film (10) which displays a spectrum of colors that shimmer and change due to the angle of observation. It is well known in the art that such films are used as security elements. Hence the laminated film of Wang inherently discloses a security element and Wang anticipates the claimed subject matter as broadly presented.

In response to applicants argument that claim 23 recites a printable surface of a first fragile layer and this is not found in Wang. The examiner submits Wang discloses that the transparent layers are made of “transparent thin film materials” at column2, line 32, hence the layers are deemed to be inherently printable and Wang anticipates the claim as broadly recited.

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***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

In order to reduce pendency and avoid potential delays, Group 3700 is encouraging FAXing of responses to Office actions directly into the Group...***Official- (703)872-9302...After Final-(703) 872 9303***. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into Group 3700 will be promptly forward to the examiner.

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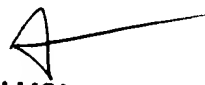
Any inquiries concerning issues other than the substantive content of this and previous communications, such as missing references or filed papers not acknowledged, should be directed to the Customer Service Representative, Tech Center 3700, (703) 306-5648.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Tech Center receptionist whose telephone number is (703) 308-1148.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to W. Fridie, Jr. whose telephone number is (703) 308-1866.

wf

January 25, 2003



**WILLMON FRIDIE, JR.  
PRIMARY EXAMINER**